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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,883	10/10/2001	John R. Hind	RSW920010194US1	7074

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EXAMINER
WOO, ISAAC M

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/973,883	HIND ET AL.
	Examiner	Art Unit	
	Isaac M. Woo	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>6/20/05</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,8 and 10-19* is/are rejected.

7)☒ Claim(s) *6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/13/05</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June

20, 2005 has been entered.

2.   Claims 1, 3, 6-8 and 10-19 are amended. Claims 1-8 and 10-19 are pending.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 1-8 and 10-17 are rejected under 35 U.S.C. § 101 because the claimed

invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the

Invention

The claimed invention as a whole must accomplish a practical
application. That is, it must produce a "useful, concrete and tangible
result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of
this requirement is to limit patent protection to inventions that possess a
certain level of "real world" value, as opposed to subject matter that
represents nothing more than an idea or concept, or is simply a starting.
point for future investigation or research (Brenner v. Manson, 383 U.S. 519,
528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26
USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure
should contain some indication of the practical application for the claimed
invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under
the patent eligibility standard requires significant functionality to be
present to satisfy the useful result aspect of the practical application
requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely
claiming nonfunctional descriptive material stored in a computer-readable
medium does not make the invention eligible for patenting. For example, a
claim directed to a word processing file stored on a disk may satisfy the
utility requirement of 35 U.S.C. 101 since the information stored may have
some "real world" value. However, the mere fact that the claim may satisfy
the utility requirement of 35 U.S.C. 101 does not mean that a useful result
is achieved under the practical application requirement. The claimed
invention as a whole must produce a "useful, concrete and tangible" result to
have a practical application.

Regarding claim 1, a method for indicating criteria for organizing electronic

objects, can be implemented without computer or machine. Because the limitation of

claim 1, "detecting", "comparing" and "storing" can be implemented by a human with a

pencil, and a piece of paper for indicating criteria for organizing electronic objects. Thus,

the languages of claim 1 raises a question as to whether the claimed method is directed

merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible

result to from the basis of statutory subject matter under 35 U.S. C. § 101. Therefore,

the claimed invention is non-statutory subject matter. The claims should be amended to

indicate that the subject matter is implemented by a computer, i.e., a computer

implemented method

Regarding claim 18, a system for indicating criteria for organizing electronic

objects includes *no physical structure of the machine in terms of its hardware or

hardware and software combination.* Because the limitation of claim 18, "means for

detecting", "means for comparing", "mean for storing" and "means for using" are

software system that are not embedded any a computer-readable medium and run by

any a computer or machine. Therefore, the claim is not a statutory system and should

be rejected under § 101 as not being tangible.

Regarding claim 19, a computer program product for indicating criteria for

organizing electronic objects. The limitation of claim 19, "computer-readable program

code means for detecting", "computer-readable program code means for comparing", "

computer-readable program code means for storing" and "computer-readable program

code means for using" program products that are embedded any a computer-readable

medium but not run by any a computer or machine. Therefore, the claim is not a

statutory system and should be rejected under § 101 as not being tangible. The claims

should be amended to indicate that the subject matter is implemented, run, or

executable by a computer or machine.

Claim Rejections - 35 USC § 112

5.   Claims 1 and 18-19 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claims 1, 6, 11-13, 15 and 17-19 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Claim 17 recites "that" in lines 3

and 9, and "such that " in line 11. Claim 18 recites "that" in lines 3 and 9, and "such that

" in line 13. Claim 18 recites "that" in lines 3 and 9, and "such that " in line 11. Claim 18

recites "that" in lines 3 and 9, and "such that " in line 13. Claim 6 recites "that " in line 13.

Claims 11-13 and 15 recite "that" in line 2. Claim 17 recites "so that in line 3. Pronouns

are not permitted, only what is being referred by "that" should be set forth in the claim.

May be renders the claim indefinite by failing to point out hat is being performed.

Applicants are advised to amend the claim so solve the 112 rejection set forth in the

claim.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-5, 7-8 and 10-19 are rejected under 35 U.S.C. 102(e) as being

anticipated by Smith et al (U. S. Pub. No. 2003/0105765, hereinafter, "Smith").

        With respect to claim 1, Smith discloses, detecting, by a user input monitor (by

cursor control device (105, fig. 1) or keyboard (106), fig. 1, page 3, section [0041]), a

user has swiped (user selecting objects) an element of a rendered presentation of an

electronic object (page 5, section [0077], page 3, section [0050]), user selecting objects

to be represented, 511, fig. 5B, page, section [0090]-[0094], page 4, section [0057]);

comparing a manner in which the swiping was performed, responsive to the detecting,

to previously-defined settings, specify what manner of swiping indicates an identification

of dynamically-identified (801-804, new object added is defined by each step), user-

defined organizing criteria (group, page 3, sections [0050]-[0057]), once user selects

the objects to be grouped, system checks each group for each objects); and storing, if

the comparing step determines, the manner in which the swiping was performed is

consistent with the specified settings, the swiped element in a repository of criteria, the

stored element can be selected for inclusion in a pattern to be matched against

electronic objects for organizing the electronic objects, see (page 2, section [0022],

page 4, section [0054], [0057], page 9, section [0140], fig. 5B, fig. 9A, user selected

objected is grouped and stored on storage medium).

With respect to claim 2, Smith discloses, enabling the user to configure the

defined setting, see (page 4, section [0054], [0057]).

With respect to claim 3, Smith discloses, repeatedly swiping a word, a phrase, or

one or more contiguous characters in the rendered representation, and the storing steps

stores the swiped word, phrase, or one or more contiguous characters as the stored

element, see (page 9, section [0140]).

With respect to claim 4, Smith discloses, the word, phase, or the characters

is/are rendered from a text document, see (page 9, section [0140]).

With respect to claim 5, Smith discloses, the word, phase, or the characters

is/are rendered from an e-mail message, see (page 9, section [0140]).

With respect to claim 7, Smith discloses, swiping one or more words, phrases, or characters in the rendered representation as the element, see (page 4, sections [0052]-[0057]).

With respect to claim 8, Smith discloses, swiping a portion of images in the rendered representation as the element, see (page 4, sections [0052]-[0057]).

With respect to claim 10, Smith discloses, building one or rules, each rule specifying a pattern, comprises at least one organizing criteria to be matched against electronic objects for organizing the electronic objects, wherein the stored element id used as one of the organizing criteria in at least one of the rules, see (fig. 9A, page 8, sections [0117]-[0130]).

With respect to claim 11, Smith discloses, detecting, the user swiped the element by moving a mouse device across the element at least twice, see (fig. 1, page 3, section [0041]).

With respect to claim 12, Smith discloses, detecting, the user swiped the element by moving a light pen device across the element at least twice, see (fig. 1, page 3, section [0041]).

With respect to claim 13, Smith discloses, detecting, the user swiped the element by moving his or her finger at least twice across the element, wherein the element is rendered on a plasma panel device, see (fig. 1, page 3, section [0041]).

With respect to claim 14, Smith discloses, detecting, the user swiped the element using an audio mechanism by speaking commands in the manner specified in the previously-defined settings, see (fig. 1, page 3, section [0041]-[0043]).

With respect to claim 15, Smith discloses, detecting, the user swiped the element using a video mechanism by passing his or her eyes repeatedly over the element, see (fig. 1, page 3, section [0041]-[0043]).

With respect to claim 16, Smith discloses, swiped multiple times to indicate the identification, see (page 5, sections [0074]-[0080]).

With respect to claim 17, Smith discloses, adding the swiped element to organizing criteria of an index, the index becomes adaptive to the user swipings, see (page 5, sections [0074]-[0080]).

With respect to claim 18, Smith discloses, With respect to claim 1, Smith discloses, detecting, by a user input monitor (by cursor control device (105, fig. 1) or keyboard (106), fig. 1, page 3, section [0041]), a user has swiped (user selecting

objects) an element of a rendered presentation of an electronic object (page 5, section

[0077], page 3, section [0050]), user selecting objects to be represented, 511, fig. 5B,

page, section [0090]-[0094], page 4, section [0057]); comparing a manner in which the

swiping was performed, responsive to the detecting, to previously-defined settings,

specify what manner of swiping indicates an identification of dynamically-identified (801-

804, new object added is defined by each step), user-defined organizing criteria (group,

page 3, sections [0050]-[0057]), once user selects the objects to be grouped, system

checks each group for each objects); and storing, if the comparing step determines, the

manner in which the swiping was performed is consistent with the specified settings, the

swiped element in a repository of criteria, the stored element can be selected for

inclusion in a pattern to be matched against electronic objects for organizing the

electronic objects, see (page 2, section [0022], page 4, section [0054], [0057], page 9,

section [0140], fig. 5B, fig. 9A, user selected objected is grouped and stored on storage

medium), using stored element as an organizing criteria in a rule, the rule can

subsequently be used for organizing the electronic objects, see (fig. 9A, fig. 5B, page 6,

sections [0091]-[0094], page 1, sections [0013]-[0022]).

With respect to claim 19, Smith discloses, With respect to claim 1, Smith

discloses, detecting, by a user input monitor (by cursor control device (105, fig. 1) or

keyboard (106), fig. 1, page 3, section [0041]), a user has swiped (user selecting

objects) an element of a rendered presentation of an electronic object (page 5, section

[0077], page 3, section [0050]), user selecting objects to be represented, 511, fig. 5B,

page, section [0090]-[0094], page 4, section [0057]); comparing a manner in which the

swiping was performed, responsive to the detecting, to previously-defined settings,

specify what manner of swiping indicates an identification of dynamically-identified (801-

804, new object added is defined by each step), user-defined organizing criteria (group,

page 3, sections [0050]-[0057]), once user selects the objects to be grouped, system

checks each group for each objects); and storing, if the comparing step determines, the

manner in which the swiping was performed is consistent with the specified settings, the

swiped element in a repository of criteria, the stored element can be selected for

inclusion in a pattern to be matched against electronic objects for organizing the

electronic objects, see (page 2, section [0022], page 4, section [0054], [0057], page 9,

section [0140], fig. 5B, fig. 9A, user selected objected is grouped and stored on storage

medium), using stored element as an organizing criteria in a rule, the rule can

subsequently be used for organizing the electronic objects, see (fig. 9A, fig. 5B, page 6,

sections [0091]-[0094], page 1, sections [0013]-[0022]).

Allowable Subject Matter

8.   Claim 6 is objected to as being dependent upon a rejected base claim, but would

be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 1, 2005
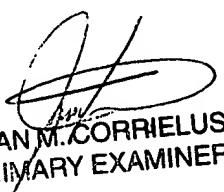
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